

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
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 STEFAN IHDE)
) Group Art Unit: 3732
)
 Application No.: 10/714,200) Examiner: WERNER, Jonathan S.
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 Filed: November 14, 2003)
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 For: Bone-Adaptive Surface Structure)
)
 Attorney Docket No. 74087-006)

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Attention: Board of Patent Appeals and Interferences

REPLY BRIEF

Grounds of Rejection

35 USC §112

Claims 58-60, 69-71 and 75-78 stand rejected under 35 USC §112 first paragraph.

The Examiner's answer fails to adequately rebut or even acknowledge the clear and specific citation to support in the original specification for the claim terms questioned under § 112. In fact, the record has never adequately provided a reason for these rejections other than to state the Examiner's preference for more "precision," meaning narrowness. Because the Examiner's answer fails to reply, fails to provide any rationale

for the rejection, the record fails to adequately support the Examiner's burden of proof for the rejection.

Examiner's answer with regard to the claim structure of "an inner aspect" and "a peripheral aspect" ignores the specific recitations to support in the specification expressly spelled out in the appeal brief, i.e., page 7, line 29 through page 8, line 14 and the figures cited therein, wherein it says in part, "... the surface structures according to the invention either maintain the central height H3 or, as shown in the right part, C, diminish outwardly and are less high in the *peripheral region* of base 2, resulting in a core height H2."

With regard to structural recitation of "leading portion" and "trailing portion", the examiner's answer continues its practice of selective editing and omitting the expressly cited support for the claim limitation. The examiner's answer states at the bottom of page 12, "however, line 20 of page 8 states that 'A' indicates a direction.'" In point of fact, page 8, line 20 of the specification states, in full, "'A' indicates a direction *opposite to the insertion path.*'" Ignoring the express statements in the specification cannot properly support a § 112 rejection.

With regard to the claim recitation of a "waist," Figure 9 speaks for itself and is abundantly clear to those of skill in the art.

35 USC §102

Independent claims 42 and 58 stand rejected as anticipated by U.S. Patent No. 6,238,214 to Robinson. The office action and Examiner's answer are based on the false premise that either the pending claims or the Robinson device can be turned upside down.

The application of this false premise is no more successful in legal analysis than it is in common sense. The “base” claimed in independent claims 42 and 58 is a base to be inserted entirely within the bone. The Robinson plate is not.

The entire disclosure of the present specification can only be understood by one of skill in the art as a base inserted in the bone. Indeed, the first paragraph of the disclosure, the technical field, states, “the invention concerns bone adaptive surface structures for lateral jaw implants; that is, for implants which are inserted into the jaw from the side and which are known as ‘disc implants’.”

This simple fact is reflected in the structural recitation of claim 42 wherein the last limitation states “both of said top surface and said bottom surface [of said base] being disposed for osseo integration.” Osseo integration means bone integration. Obviously, both surfaces of a base cannot integrate with a bone unless they are inside the bone. This ordinary straight forward interpretation of the structural claim recitations is further required by the recitation that “a first end [of the implant shaft] having a mount for the device to be implanted [a tooth]; said second end being attached to a top surface of a base.”

The Robinson ‘214 reference discloses no such thing. It is abundantly clear to both those of skill in the art and the layman that it is directed to a fundamentally different device, starting with the title, “Guided Tissue Regeneration Plate for Use in a Process for Growing Jaw Bone in Anticipation of Performing Dental Implants.” In it is disclosed a tissue regeneration plate (12) that is not disclosed as being inserted in bone, or even being inserted *on* bone. Rather, its shaft is to be inserted in the bone and the plate portion to be

formed into an empty area (not touching bone) in order to define a space wherein it is desired that bone should grow, *see* space 13 in Figure 4 and *see* column 6, lines 43 through 54. There is no place in the Robinson reference wherein the tissue regeneration plate 12 ever has osseo integration occurring with both its top surface and bottom surface, as claimed. There is no “first end having a mount for a device to be implanted” and there is no “osseo integration on both the top and bottom surfaces of the reference plate,” as claimed. Hence the anticipation analysis here coincides with a common sense analysis. A “guided tissue regeneration plate” is not a “base” as claimed, and neither the Robinson device nor claim 42 may be turned upside down to make it so.

With regard to the Robinson guided tissue regeneration plate being read as a base, the examiner’s answer cites dictionary.com as defining a base as “the bottom *support* of anything,” or alternatively “that on which a thing *stands or rests*.” The guided tissue regeneration plate of the Robinson reference does not support the shaft. Once again, the Robinson reference has been inverted in this misapplied anticipation analysis. In actuality, it is the shaft, anchored in the bone, that supports the guided tissue regeneration plate which, when installed, is suspended in the patient’s mouth by the shaft and otherwise unsupported. Similarly, because it is otherwise unsupported, the guided tissue regeneration plate is not “the thing on which the shaft stands or rests”. The points raised in the examiner’s answer best support the allowability of claims.

The same is true for independent claim 58. Independent claim 58 recites that a first end of the implant shall have a mount for a device to be implanted (a tooth). The second end is “terminally attached to a top surface of a base [to be implanted in the

bone]”. Again, a “guided tissue regeneration plate” is not a base. The tooth end of the recited claim cannot be inverted by examiner fiat. Because the Robinson reference fails to anticipate the independent claims 42 and 58, it cannot anticipate the dependent claims either in this case.

With regard to the structural recitations of what is mounted at either end of the shaft in the pending claims, the examiner’s answer adds nothing to the examiner’s previous position. The remarks on page 10 of the examiner’s answer cite reference numeral 17 in Figures 11 and 17 in the Robinson reference as anticipating the claimed “device to be implanted.” Numeral 17 is the shaft. It is an integral, unitary shaft without other structures incorporated into it. It cannot be read as anticipating both the shaft and the “device to be implanted” of the presently pending claims.

“The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.” *See, In re Cortright*, 165 F3d 1353, 159 (Fed. Cir. 1999) MPEP 2111. No one of skill in the art would mistake the shaft for being both a shaft and a tooth in the presently pending claims. No one of skill in the art would understand the shaft 17 in the Robinson reference to be both the shaft and the device to be implanted, i.e., the tissue regeneration plate.

Independent claim 72 stands rejected as anticipated by the Albrektsson reference (WO01/24737). The examiner’s answers remarks on page 11 are merely conclusory, and, once again, wrong. Again, the structural recitation of the pending claim are ignored and do not read on the Albrektsson reference.

The claim recites “a substantially planar base at one end.” The examiner’s answer cites element 20 in the figures as substantially planar base at one end. It is not. The reference itself defines element 20 as “a collar section 20”. *See*, page 12, line 17. A collar is not a base.

Even more clear to either a layman or one of skill in the art is the claim recitation that “said base comprising a substantially T-shaped implant end portion”. The Albrektsson implant is not T-shaped. A person of skill in the art would understand the Albrektsson reference the same way a layman would; there is a shaft with an intrabone portion 3 and a portion of the same shaft 5 that protrudes from the bone. These are identified in the first sentence of the detailed disclosure as “an intra osseous anchoring section 3” and “a head section 5.” *See* page 8, lines 26-27. There is no T-shaped device disclosed in the Albrektsson reference.

Moreover, the claims recite “said T-shaped end portion being disposed for osseo integration and an *opposite* end portion being disposed to protrude from the bone. Thus, even if the claim language and the law were abused to read collar 20 as a T-shaped base as recited in the pending claims, this T-shaped base portion is not disposed for osseo integration as claimed. As explained in the Albrektsson reference, “the collar section 20 delimits the insertion of the intra osseous anchoring section 3 into the bore in the femur neck by abutting with the resected femur section 33 adjacent the opening to the cavity 30.” *See* page 12, lines 21-24. Apparently, the examiner’s answer has in mind that the T-shaped end section is comprised of the collar 20 and the head section 5. This is clearly the opposite of what is disclosed in the Albrektsson reference wherein it is stated, “that

head section 5 of the femur fixture 1 has a collar section 20 and a tapered mounted portion 23 for the ball component 25 for the hip joint prosthesis to be mounted on.” *See*, page 12, lines 16-19.

In addition to being the opposite of the Albrektsson disclosure, such an interpretation of the T-shaped end portion would require ignoring the very next structural recitation of the claim, which is that end of the shaft *opposite* the T-shaped end portion comprises “an opposite end portion being disposed to protrude from a bone.” Predictably, this claim limitation is nowhere referenced in the examiner’s answer. The structural recitations of independent claim 72 not being found in the Albrektsson reference, and many structural recitations being exactly the opposite of what is disclosed in the Albrektsson reference, the Albrektsson reference cannot anticipate claim 72. The remaining dependent claims, which depend from independent claim 72, cannot be anticipated by the Albrektsson for the same reason that claim 72 from which they depend is not anticipated by the Albrektsson reference.

35 USC §103

Claims 44-45, 48, 54 and 56 all stand rejected as obvious under 35 USC §103. The primary reference for each of these is the Robinson reference. For the reasons stated above, the primary reference, the Robinson ‘214 patent, teaches the exact opposite of the presently pending claims. That is, it teaches a device that is inverted 180 degrees from the claimed device in relation to the bone into which it is to be implanted. (Assuming for the sake of argument that the many other failings of the primary reference to teach the recited claim structure may be overlooked.) Teaching away is expressly referenced in

KSR v. Teleflex, 550 US1 (2007) as evidence of non-obviousness. Because the Robinson reference teaches the opposite of what is claimed, the Robinson reference cannot form the basis of an obviousness rejection of the pending claims.

Respectfully submitted,



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